

REMARKS

Claims 1-9 and 11-15 are pending in the application.

Claims 1-9 and 11-15 are rejected under 35 USC 103(a) as being unpatentable over Schmid et al. (US Patent No. 5,659,164).

With regard to claims 1 and 8, it was stated in the office action, "Schmid fails to expressly teach wherein the control sheet could be located in a position other than at a first page of the imaging job. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to place the control sheet in a position other than at the first page of the imaging job. Applicant has not disclosed that placing the control sheet in a position other than at a first page of the imaging job provides an advantage."

First, Applicant is unaware of any requirement in which the Applicant is required to disclose some advantage of a particular claim limitation. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143.

Second, the specification mentions the advantages of not having the control sheet in the first position. See page 1, line 24 through page 2, line 4, and page 5, line 19 through page 6, line 2. Therefore, one of ordinary skill in the art would *not* have expected Applicant's invention to perform equally well with either location of the control sheet of Schmid or the claimed location of the control sheet because both location "perform the same function of imaging document." Indeed, as discussed in Applicant's specification on page 6, line 15

through page 7, line 5, there may be more functionality to be had if the control images are provided and processed after the print job.

It is therefore submitted that claims 1 and 8 are patentably distinguishable over the prior art and allowance of these claims is requested.

Claims 2-7 depend from claim 1 and inherently contain all of the limitations of that claim. As discussed above, the prior art does not teach, show nor suggest all of the limitations of the base claim, much less the further embodiments of the dependent claims.

Specifically, with regard to claim 7, it is unclear how there are two control sheets. On Page 4 of the Office Action, it is stated that 'wherein at least one sheet is a control sheet containing only control information and there is only one control sheet containing operating instructions for the imaging job (see 'cover page 1 and 'cover page 1'...' The office action then goes on to state with regard to claim 7 that cover page 1 is the second control sheet.

First, cover page 1 cannot be both the first and second control sheets. It has to be either one or the other.

Second, if cover page 1' was intended as being the first cover page, it is not for the same job, as is required by claim 7.

Third, cover pages 1 and 1' both contain operating instructions for the different jobs, while claim 7 specifically requires that the second control image contain control information 'other than operating instructions.'

It is therefore submitted that claims 2-7 are patentably distinguishable over the prior art and allowance of these claims is requested.

Claims 9 and 11-15 depend from claim 1 and inherently contain all of the limitations of that claim. As discussed above, the prior art does not teach, show nor suggest all of the limitations of the base claim, much less the further embodiments of the dependent claims. With regard to claim 15, please see the arguments with regard to claim 7 above. It is

therefore submitted that claims 9 and 11-15 are patentably distinguishable over the prior art and allowance of these claims is requested.

No new matter has been added by this amendment. Allowance of all claims is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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